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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/522,835 | 01/31/2005 | Anne Hupp | PAT-01087 | 6570 |
| 26/922 | 7590 | 04/28/2008 | | |
| BASF CORPORATION Patent Department 1609 BIDDLE AVENUE MAIN BUILDING WYANDOTTE, MI 48192 | | | EXAMINER ABU ALL, SHUANGYI | |
| | | | ART UNIT 1793 | PAPER NUMBER |
| | | | NOTIFICATION DATE 04/28/2008 | DELIVERY MODE ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

LORLHASS@BASF.COM
MARJORIE.ELLIS@BASF.COM
ANNE.SABOURIN@BASF.COM

Office Action Summary

Application No.

10/522,835

Applicant(s)

HUPP ET AL.

Examiner

SHUANGYI ABU ALI

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

(1)

Status of Claims

Claims 1- 15 remain for examination.

(2)

Claim Rejections - 35 USC § 103

The rejection of claims 1-15 rejected under 35 U.S.C. 103(a) as being unpatentable over Sapper (US 6,284,037) in view of Bergfried (CA 2,154,818) as generally set forth in the previous office action mailed 10/18/2007 stands.

The rejection of claims 1-2, and 4-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jakubauskas (US 3,980,602) in view of Sapper (US 6,284,037) and Bergfried (CA 2,154,818) as generally set forth in the previous office action mailed 10/18/2007 is withdrawn in view of applicants argument.

The text of those sections of title 35 US Code not included in this action can be found in the prior Office Action.

(3)

Response to Arguments

The Examiner thanks the applicant pointing out the typo in the previous office action.

Applicant's arguments filed 1/15/2008 have been fully considered but they are not persuasive.

Applicants argue that t Sapper teaches compositions containing a grinding resin which is outside the scope of the instant claims. The examiner respectfully submits that Sapper teaches an acrylate polymer which is used to adjust viscosity and stabilize coating formulations (col. 1, lines 53-54). While such polymers may be used as grinding aids as shown by other references as cited by applicant, such is not explicitly taught by Sapper. In fact, Sapper makes no reference to grinding the composition and it has not been shown why one of ordinary skill would want to grind the composition.

Applicants argue that Sapper does not teach the use of its composition as a pigment paste which excludes binder. The Examiner respectfully submits that Bergfried teaches that the nonassociative rheology stabilizer taught by Sapper can be used to prepare pigment pastes. Given that Sapper discloses a composition comprising aluminum, nonassociative thickener, nonionic surfactant, amine, and water and further given that pigment pastes are known to contain such ingredients before being added to a binder as taught by Bergfried, it would have been obvious to one of ordinary skill in the art to prepare the presently claimed pigment paste before adding to a binder to prepare a coating composition. In other words, to mix ingredients in a different order is obvious. Case law holds that the selection of any order of mixing ingredients is *prima facie* obvious. *In re Gibson*, 39 F.2d 975, 5 USPQ 230 (CCPA 1930).

Applicants argue that t the examiner has used improper hindsight to arrive at the instant invention it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the

claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicants argue that the amount of aluminum is not obvious from the teachings of Sapper and Bergfried because the maximum amount of pigment is critical. The Examiner respectfully submits that Bergfried discloses a pigment concentrate comprising 40-60 wt % pigment. While this amount is greater than the presently claimed amount of 15-40 wt %, it is the examiner's position that the criticality of the maximum amount is not relevant because the amount of aluminum rendered *prima facie* obvious is less than the amount taught by Bergfried. No criticality has been disregarded by the examiner.

Applicants argue that there is too much picking and choosing by the examiner to combine Sapper with Bergfried. The Examiner respectfully submits that a reference is good not only for what it teaches but also for what one of ordinary skill might reasonably infer from the teachings. In re Opprecht 12 USPQ 2d 1235, 1236 (CAFC 1989); In re Bode USPQ 12; In re Lamberti 192 USPQ 278; In re Bozek 163 USPQ 545, 549 (CCPA 1969); In re Van Mater 144 USPQ 421; In re Jacoby 135 USPQ 317; In re LeGrice 133 USPQ 365; In re Preda 159 USPQ 342 (CCPA 1968). In addition, "A reference can be used for all it realistically teaches and is not limited to the disclosure in its preferred embodiments" See In re Van Marter, 144 USPQ 421). Second, it is not picking and choosing to select one element from one list, however long the list may be. When the species is clearly named, the selection from a long list does not avoid a 103 rejection.

See Ex parte A, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990) (The claimed compound was named in a reference which also disclosed 45 other compounds. The Board held that the comprehensiveness of the listing did not negate the fact that the compound claimed was specifically taught. See also In re Sivaramakrishnan, 673 F.2d 1383, 213 USPQ 441 (CCPA 1982). Specifically, the examiner only relied on the example in Sapper to teach aluminum as a suitable pigment in the compositions taught by Sapper and to teach the amounts in a final coating composition made from a pigment paste taught by Sapper and Bergfried.

Applicants argue that the conductive pigments taught by Bergfried are not equivalent to the aluminum taught by Sapper. The Examiner respectfully submits that both reference teaching of aqueous pigment in a coating composition and both pigment are conductive.

(4)

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHUANGYI ABU ALI whose telephone number is (571)272-6453. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jerry A Lorengo/
Supervisory Patent Examiner, Art Unit 1793

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